

REMARKS

Claims 1-15 are pending in the present application. Claims 11-15 are withdrawn from consideration. Claims 1-10 are rejected.

Claim Rejections - 35 U.S.C. §103(a)

Claims 1-7 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tolliver et al. (U.S. Patent No. 5,069,964) in view of Buccellato et al. (U.S. Patent Application Publication No. 2002/004135).

Claims 8-10 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tolliver in view of Buccellato as applied above, and further in view of Ojeda et al. (U.S. Patent No. 6,326,072).

The Examiner asserts that Applicant's arguments in the response filed September 17, 2009 have been considered but are deemed unpersuasive. In response to Applicant's arguments that the residual rate or the fall time of the pressure sensitive is not inherent to the adhesive of Buccellato, the Examiner simply repeats that Buccellato discloses the adhesive of Applicant, and asserts that it would inherently exhibit the claimed properties.

In spite of Applicant's extensive remarks with regard to why the adhesive of Buccellato would not inherently exhibit the claimed residual rate and fall time, the Examiner merely repeats her assertion that the products "are identical in structure and/or composition" and "there is no evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product".

The Examiner emphasizes that the arguments of counsel cannot take the place of evidence in the record. The Examiner cites the Manual of Patent Examining Procedure (MPEP) §716.01(c) for examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration. MPEP §716.01(c) indicates that

Examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration *include statements regarding unexpected results, commercial success, solution of a long-felt need, inoperability of the prior art, invention before the date of the reference, and allegations that the author(s) of the prior art derived the disclosed subject matter from the applicant.*

However, Applicant respectfully submits that the Examiner is mischaracterizing the evidence asserted in the previous Response. In the previous Response, the arguments tending to show that it cannot be automatically determined that the claimed residual rates and the fall times of the pressure-sensitive adhesive layer of a similar composition would inherently fall in the ranges of the present invention generally directed the Examiner to various areas of the Specification.

Applicant notes that such argument should not be dismissed as mere attorney argument. The MPEP §2145 indicates that “rebuttal evidence and arguments can be presented in the specification, *In re Soni*, 54 F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995), by counsel, *In re Chu*, 66 F.3d 292, 299, 36 USPQ2d 1089, 1094-95 (Fed. Cir. 1995), or by way of an affidavit or declaration under 37 C.F.R. §1.132, e.g., *Soni*, 54 F.3d at 750, 34 USPQ2d at 1687; *In re Piasecki*, 745 F.2d 1468, 1474, 223 USPQ 785, 789-90 (Fed. Cir. 1984).

The MPEP §2145 further specifically indicates that “Office personnel should consider all rebuttal arguments and evidence presented by applicants. See, e.g., *Soni*, 54 F.3d at 750, 34 USPQ2d at 1687 (error not to consider evidence presented in the specification).”

The Examiner further indicates that the comparative examples in the instant specification are “not commensurate in scope with the prior art”, and therefore Applicant has not provided evidence that the combination of Tolliver and Buccellato do not necessarily posses the characteristics of the claimed product.

Applicant respectfully asserts that the Examiner is conflating evidentiary requirements associated with demonstration that a cited reference fails to exhibit a claimed parameter with evidentiary requirements associated with showing that a cited reference does not necessarily exhibit a claimed parameter.

Applicant would agree that only if Applicant was trying to prove that the asserted combination of Tolliver and Buccellato do not possess the claimed properties, the examples would have to be commensurate with the cited combination of references. However, if the previously submitted argument is properly considered, Applicant has effectively demonstrated that the claimed properties are not *inherent* in the material of the cited combination of references. That is, Applicant has shown that it cannot be automatically determined that the residual rates and the fall times of the pressure-sensitive adhesive layer of a similar composition would *inherently* and necessarily fall in the ranges of the present invention. Applicant has shown that it is necessary to select the components in the composition and the contents thereof *specifically* so

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Response for Reconsideration under 37 C.F.R. §1.116
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that the residual rate and the fall time of the pressure-sensitive adhesive layer fall in the ranges of the present invention.

Because the material of the asserted combination of Tolliver and Buccellato do not necessarily possess the claimed properties, Applicants have effectively overcome the rejection.

In view of the accompanying remarks, Applicant submits that the rejections are shown to be overcome and the claims are therefore in condition for allowance. Applicant requests such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact the undersigned attorney to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicant respectfully petitions for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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